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Application Number	09/585,222
Filing Date	June 1, 2000
First Named Inventor	Roger MASSEY
Group Art Unit	3732
Examiner Name	D. Austin BONDERER
Attorney Docket Number	GEMVAL P15AUS

Total No. of Pages in this Submission: 8

ENCLOSURES (check all that apply)

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REMARKS

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual Name	Scott A. Daniels DAVIS & BUJOLD, P.L.L.C.	Reg. No. 42,462 CUSTOMER NO. 020210
Signature		
Date	March 25, 2005	

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 25, 2005

Type or printed name. Scott A. Daniels

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Date: March 25, 2005



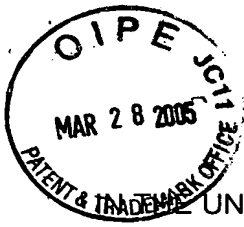
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

Appeal Number

In re Application of	:	Roger MASSEY
Serial no.	:	09/585,222
Filed	:	June 1, 2000
For	:	BAR-STOCK BALL VALVE
Group Art Unit	:	3732
Examiner	:	D. Austin BONDERER
Docket	:	GEMVAL P15AUS

APPELLANT'S REPLY BRIEF
TO EXAMINER'S ANSWER

03/25/5



REPLY BRIEF

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Roger MASSEY
Serial no.	:	09/585,222
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Group Art Unit	:	3732
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Docket	:	GEMVAL P15AUS

The Hon Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

This Reply Brief is being filed in support of Appellant's Appeal Brief mailed on September 29, 2004 and further in reply to the Examiner's Answer mailed January 28, 2005.

First, noting the case law cited in the Examiner's Answer, Ranco. Inc. v. Gwynn, 128 F.2d 437 the Appellant notes that this is a 1942 case alleging, "a difference which consists of a mere omission or something which a skillful mechanic could supply, is not fatal to anticipation." Notwithstanding the precedential value of this decision as discussed in further detail below, the Appellant believes that the presently claimed apparatus and method is more than a "mere omission". As discussed ad nauseam in the Appellant's Responses and Appeal Brief, the claimed invention relates to a novel ball valve and method of manufacturing a ball valve with an eccentrically located flow port which efficiently reduces the size of the necessary pre-selected bar stock as well as the initial machining requirements. The resulting ball valve is thus provided with a thinner and thicker wall defining a substantially uniform outer wall dimension facilitating use of a conventional sized valve stem which is entirely different both structure, function and manufacture from the conventional ball valve disclosed by Matousek '516.

Sheperdizing® the case reveals that Ranco is precedentially cited solely for issues under 35 U.S.C. §101 regarding new use for known products and, not as far as the Appellant is aware, for the viability regarding its dicta opining on the prior art evidence considered by the Court.

The Appellant points out that the Court's language on this point is merely dicta and as the Board is certainly aware, dicta is non-precedential. This language merely explains the decision upholding anticipation based on the evidence of five (5) prior art references and the testimony of two expert witnesses. Even if the Court's decision in this matter is precedential, the Examiner has applied only a single reference, i.e., Matousek '516, to claim 1 and added his own subjective belief as to the relative skill in the art of ball valve manufacture. An objective comparison of Ranco to the present anticipation rejection dictates that the Examiner's reliance upon a single reference and personal belief as to the state of the art are insufficient to support the alleged anticipation rejection.

Turning to the merits of the present application, the Examiner has rejected the Appellant's pending claims 1, 2, 5 and 7 as anticipated by Matousek '516 under 35 U.S.C. §102(a). Noted in the Examiner's Answer at page 4, lines 1-3 "[t]o anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter". Contrary to this the Examiner next states at lines 8-9, "[h]owever, the reference would clearly teach to an artisan skilled in the art to make the claimed apparatus." The Appellant believes that the Examiner has confused an anticipation rejection with the legal elements for a showing of non-obviousness. Moreover, the Examiner is attempting to justify the lack of proper support for the anticipation rejection based on merely his own subjective interpretation of the Appellant's claim language and his own asserted cognizance of what is known to those of skill in the art. Such a conflagration of arguments and analysis as generally summarized in the Examiner's Answer has now apparently become a pretext to maintain the current anticipation rejection.

Whether the Examiner is trying to show anticipation or non-obviousness, the Examiner has not properly supported a rejection of the Appellant's claims under either 35 U.S.C. §102 or §103. Rather than applying the relevant portions of the Matousek reference which disclose, teach or suggest the presently claimed invention as required by case law, the Examiner has embarked upon

a relative Markman analysis of the Appellant's claim language and attempted to shoehorn the Appellant's claims into an imagined disclosure of the cited reference.

For example while stating "[I]t is a well known rule that claims are to be given their broadest interpretation[]", the Examiner is actually broadly construing the disclosure of Matousek `516 and the ball valve shown therein. The Examiner then relates this broad construction of Matousek's ball valve housing, which is hardly uniform, to a narrow interpretation of the legal scope of the term "substantially". Thus, despite his assertion to a broad construction of the Appellant's claims, the Examiner is actually narrowly defining the Appellant's claims in an attempt to conform to an overbroad interpretation of the disclosure of Matousek `516.

The most recent edition of Chisum, 3-8 Chisum on Patents §8.03 (2005) specifically addresses the scope of the term "substantially" in accordance with Judge Learned Hands discussion in Musher Foundation v. Alba Trading Co., (1945). "(Substantially" is not of itself fatal to a claim; Eibel Process Co. V. Minnesota & Ontario Paper Co., ...: indeed, it must always be implied in every claim, even when not introduced, and adds nothing when it is. Were this not true, few patents could be given any protection, for some departures from the precise disclosure are nearly always possible without losing the benefit of the invention.) ...It is impossible to suppose that anyone who really wished to respect the patent would have any difficulty in identifying what the claim covered."

The Examiner subsequently alleges that "[t]he [Appellant's] argument is predicated on an artisan taking a simple piece of barstock and machining it down to the desired shape", page 4, last sentence. We agree and believe that the Matousek `516 reference supports this proposition by clearly showing a highly machined valve. Conventional machining and casting methods are, in fact, all that is as discussed by Matousek `516 at column 2, lines 61-64, "[t]hat is, it is machined from a single piece of material such as brass, stainless steel or the like. Obviously, the housing

could be of many types such as the standard cast and/or multi-piece housings". This is, in fact, the complete extent of the disclosure in Matousek `516 relative to barstock and the manufacturing of ball valves. Thus, it is hard to imagine how such minimal disclosure can be stretched to render obvious, much less anticipate the presently claimed apparatus and method.

The Examiner argues "[a] careful reading of claim 1 only requires that the barstock from which the valve is made have a substantially uniform cross-section defining the outer walls". Actually, a careful reading of claim 1 shows "a substantially uniform transverse cross-section. . ." but, more to the point, claim 1 requires that the claimed fluid control valve comprises ". . . a barstock body of preselected material having. . . a substantially uniform transverse cross-section. . .". In other words, the Applicant's valve body is more than merely selected from uniform barstock, but the valve body itself maintains. . . a substantially uniform transverse cross-section. . ." as specifically recited in claim 1. If the Examiner believes that the removal of the language "of preselected material" would make this recitation more clear and place the claims in condition for allowance, the Applicant would certainly consider such an amendment.

However, notwithstanding the Examiner's Answer, the Appellant stands on the arguments presented in the Appeal Brief relative to the current 35 U.S.C. § 102 and § 103 rejections and maintains the position that Matousek `895 actually discloses a highly machined valve housing having a substantial variation in the transverse cross-section of the valve housing 12 as well as the outer wall defined thereby. Matousek `895 does not disclose, teach or suggest a barstock body of a fluid control valve having ". . . a substantially uniform cross section defining the outer walls. . ." as claimed by the Appellant.

Turning to the Examiner's argument on page 5, regarding the alleged "uniformity" of Matousek's outer walls, the Appellant's claim 1 specifically recites ". . . a substantially uniform transverse cross-section defining the outer walls". The Appellant can find no uniformity to the

myriad of transverse cross-sections, i.e., cross-sections perpendicular to the flow bore axis, which occur along a length of the valve disclosed in Matousek `516. Notwithstanding the Examiner's alleged scope given to the term "substantially", it is hard to imagine that a transverse cross-section of the threaded end portions 18 and 20 of Matousek's valve, is substantially uniform to a cross-section of the main body of Matousek's valve as shown for example in Fig. 2. The best view of such a discrepancy between such transverse cross-sections can be seen in the longitudinal cross-section of Fig. 1 in Matousek `516.

As best the Appellant understands the Examiner's argument on page 6 relating to a "box-like" and "rectangular" shape of the Appellant's valve, the Appellant has made a thorough review of the Appellant's §112, first paragraph argument in the Appeal Brief, as well as other of the Appellant's papers, and can find no such express or inherent language or argument to which the Examiner makes reference. The Appellant, therefore, stands on the arguments as presented in the Appeal Brief. The Appellant entered this argument based on the Examiner's specifically raising the issue of new matter without actually making a formal rejection in doing so. The Appellant addressed this point to reduce the necessity for further Appeals and unnecessary prosecution in this matter. The Appellant notes the Examiner's intention stated at page 6, lines 11-13, "If the [B]oard holds that Appellant's interpretation of the claim is proper, the term is then new matter." The Appellant was warned of this in the cited Final Action." In view of the Examiner's professed intention to drag on the prosecution of this case despite the potential of the Board ruling against the Examiner for a second time, the Appellant respectfully requests that for purposes of judicial and administrative efficiency, the Board decide the issue of matter at this point in time.

Regarding the Examiner's further claim interpretation on pages 6-7. Again although the Examiner is alleging that "[t]he claim must be given its broadest interpretation", page 7, lines 2-3. The Examiner expressly narrows the Appellant's claim language stating ". . .however, it truly reads

as a whole that the flow port of the valve is eccentrically located in reference to the valve as a whole and is located on the inlet and outlet ends of the barstock.” The Examiner’s argument is contradictory by its very nature and in any event Appellant’s “. . .through machined flow port” is located eccentrically relative to the inlet and outlet ends of the Appellant’s claimed “fluid control valve” as claimed, whereas Matousek `516 only discloses the flow passage directly in the middle of the two threaded end portions 18 and 20 defining the inlet and outlet of Matousek’s valve.

Again, as best the Appellant understands, the Examiner’s arguments on page 8 of the Examiner’s Answer, the Examiner is giving an opinion as to an artisan’s skill in the field to make a ball valve similar to the Appellant’s claimed valve, based on the disclosure of Matousek `516. The Appellant respectfully disagrees. Matousek `516 does disclose “the valve housing 10 is a one piece body generally made from ‘barstock’. That is, it is machined from a single piece of material. . .”. However, there is no further disclosure, teaching or even a suggestion as to any valve or manufacturing method other than that as shown in Matousek `516, Figs. 1-4. In fact, the Figures of Matousek clearly show a highly machined or cast valve designed to accommodate the specific valve packing arrangement which is the subject of the Matousek `516 reference. If anything, this is a diametrically opposed teaching to the Examiner’s argument as well as the presently claimed invention having substantially uniform outer walls.

Finally, the Appellant takes specific issue with the Examiner’s dismissive summary relative to the novel subject matter of the present claims as expressed on page 9, last paragraph of the Examiner’s Answer, “[a]ll that is required by claim 1 is a piece of barstock with a hole eccentrically bored through two of its faces”. The Appellant points out that claim 1 is apparently rejected under 35 U.S.C. §102 for anticipation and that legal standard for anticipation is that the cited reference must disclose each and every feature or limitation of the claimed invention. The Examiner’s statement is not only contradictory to law, but also fails to rise to the level of care and consideration

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owed in the exercise of prosecution of Appellant's claims. A fair reading of the Applicant's independent claims 1 and 6 is believed to show substantially more features and limitations than expressed by such a statement.

For these reasons, as well as those set forth in the Appellant's Appeal Brief, the Appellant respectfully requests the Board to reverse the Examiner's anticipation, obvious and substantive new matter rejections and remand this application to the Examiner for allowance and issue. Accordingly, reversal of the final rejection of claims 1-3 and 5-8 is respectfully requested in view of the foregoing and issuance of a Notice of Allowance is now believed in order.

In the event that there are any fee deficiencies or additional fees are payable, please charge the same or credit any overpayment to our Deposit Account (Account No. 04-0213).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'S. Daniels', is written over a horizontal line.

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